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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/178,594 10/26/98 ISHIGURO

M U-WF-5103B-K

EXAMINER

HM12/0806

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BERCH, M

ART UNIT

PAPER NUMBER

1611

DATE MAILED:

08/06/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/178,594**

Applicant(s)  
**Ishiguro**

Examiner  
**Mark L. Berch**

Group Art Unit  
**1611**



☒ Responsive to communication(s) filed on Jul 15, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 15-19 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 15-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/318,686

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-19 are rejected under 35 U.S.C. 112, paragraphs 1 and 2, as the claimed invention is not described, or is not described in such full, clear, and exact terms as to enable any person skilled in the art to make and use the same, and/or failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. Specifically:

1. The new definition of  $R_3$  is unclear (paragraph 2) and lacking in description (paragraph 1) . Where in the specification did this language come from? A protecting group against what? As there is no such thing as a universal protecting group, correct selection of a protecting group requires some knowledge of what is being protected against. Where is the line between a protecting group which is easily removed and one that is not?
2. As stated previously in point 3, the X and Y choices starting from carboxy (page 3, 5th from last term) through the middle of line 3 of page 4 lacks description.

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Applicants point to page 2, lines 13-15. The examiner does not see it. The first choice on the list is carboxyl, i.e. COOH. Where is such a group described? (paragraph 1)

3. Original point 4 remains as well. Applicants' traverse on this point is unpersuasive. For example, the first substituent lacking description is the carboxyl, now at the end of the 5th from last line of the claim. That carboxy substituent could be on, for example, an alkenylthio group, thus providing for a carboxyalkenylthio for X.

Applicants point to page 23, lines 10-27. The examiner does not see how anything on those lines can possibly qualify as a description of the carboxyalkenylthio group which is now in the claims. (paragraph 1)

4. There still remains previous point 7. Applicants' traverse on this point is unpersuasive. An impasse has clearly been reached. The material at page 8, lines 4-18 simply does not say that zinc can be mixed with anything in choice (a). The page 8 material simply describes what is in (a), which isn't the problem. The examiner isn't questioning the accuracy of what is in the specification or saying that excessive trials will be needed to determine what works and what does not. The examiner isn't saying that it lacks enablement, only that it lacks description. The examiner is saying that nowhere in the specification does it say that a mixture of Zn with anything in (a) will work. This was a concept newly created when this claim was written. (paragraph 1)

Applicants are reminded that text added to the claims must be underscored; this was not done for a large block of missing X and Y definition material.

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*Specification*

In the parentage, "based on" is imprecise. Suggested is "which is a 371 of".

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.



Mark L. Berch

Primary Examiner

Group 1610 - Art Unit 1611

August 4, 1999